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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,355	06/30/2004	Aki Kobayashi	042275	2406
38834 7590 09/21/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER KIM, JENNIFER M	
			ART UNIT 1617	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,355	Applicant(s) KOBAYASHI ET AL.	
	Examiner Jennifer Kim	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed on July 12, 2007 have been received and entered into the application.

Action Summary

The rejection of claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Masahide et al. (JP2001-048720) in view of Kim et al. (1995) and Kato et al. (JP 04304887A) is being maintained for the reasons stated in the previous Office Action.

Response to Arguments

Applicants' arguments filed on July 12, 2007 have been fully considered but they are not persuasive. Applicants argue that that present invention has unexpected benefit (synergistic action) by combining 1,2 alkanediol and the particular perfumes (shown from Figs 2 to 8, the combination of 1,2-alkanediol), and the combination would not have been predicted by one skilled in the art at the time of the invention and it does not always result in synergistic action in the antibacterial effect by combining two compounds having antibacterial activity. Applicants further argues that the advantageous effect of synergistic action can be achieve only by combining 1,2-

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alkanediol and the particular perfume according to the present invention, Applicants submit herewith a declaration under 37 C. F. R. 1.132. The data and the declaration have been carefully reviewed and considered. However, as Applicants admit on page 6, second paragraph, that not **all** combination of any 1,2-alkanediol and perfume can yield synergistic action. Therefore, the "evidence" of synergism is not commensurate in scope with the breadth of the claims. It is well established that a showing of unexpected results generally must be commensurate in scope with the breadth of the claims sought to be patented. See, inter alia, (1) In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978) (showing of unexpected results must be commensurate in scope with breadth of claim); (2) In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990) (same); and (3) In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (same). Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

In view of the above Office Action of March 22, 2007 is deemed proper and asserted with full force and effect herein to obviate applicants' claims.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masahide et al. (JP2001-048720) in view of Kim et al. (1995) and Kato et al. (JP 04304887A).

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Masahide et al. teach a humectant and bacteriostatic agent that has a low skin irritation comprising 1,2-octanediol. Masahide et al. teach that this bacteriostatic agent can be employed as cosmetics. (abstract).

Masahide et al. do not teach citral, geraniol or perillaldehyde, and food preparation set forth in claims 10-12 and toiletries set forth in claims 4-6 and medicine set forth in claims 7-9.

Kim et al. teach that essential oils such as citral, geraniol and perillaldehyde have antibacterial activity and these compounds could serve as potential antibacterial agents to inhibit pathogen growth in food. (abstract). Kim et al. teach that for years food borne illness resulting from consumption of food contaminated with pathogenic bacteria and or their toxins has been vital concern to public health. (first paragraph under Introduction, page 2839).

Kato et al. teach the bactericides are useful in food, pharmaceuticals and cosmetics etc. (abstract).

It would have been obvious to one of ordinary skill in the art to combine citral, geraniol or perillaldehyde to Masahide et al's bacteriostatic composition because citral, geraniol and perillaldehyde have an antibacterial activity as taught by Kim et al. One would have been motivated to combine citral, geraniol and perillaldehyde to bacteriostatic agent taught by Masahide et al. in order to achieve an expected additive benefit of formulating cosmetic agent having antibacterial activity.

With regard to food preparation set forth in claims 10-12, such is obvious because for years, food borne illness resulting from consumption of food contaminated

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with pathogenic bacterial has been vital concern to public health. One would have been motivated to formulate the obvious combination in food preparation in order to achieve expected antibacterial activity to avoid food contamination which has been a vital concern to the public health as taught by Kim et al. With regard to medicine and toiletries preparation set forth in claims 4-9, such as obvious because the usefulness of bactericides in pharmaceuticals, cosmetics etc. are well known by Kato et al. One would have been motivated to prepare the bacteriostatic agent of Masahide as modified by Kim et al. in a preparation including food, pharmaceuticals and cosmetics etc., where the bactericides routinely employed and useful as taught by Kato et al.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

None of the claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

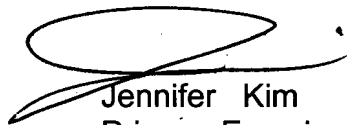
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Jennifer Kim
Primary Examiner
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Jmk
September 17, 2007